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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,631	06/21/1999	JOHN MICHAEL MANNERS	CULLN23.001A	1902

20995 7590 11/19/2003

KNOBBE MARTENS OLSON & BEAR LLP  
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IRVINE, CA 92614

EXAMINER
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ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/331,631	MANNERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hope A. Robinson	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 11-21, 30, 31, 34, 36, 37, 39-54 is/are pending in the application.
- 4a) Of the above claim(s) 12, 14, 15, 34, 36, 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 3, 19, 30, 31, 42-45, 47, 49, 52 and 54 is/are allowed.
- 6) ☐ Claim(s) 1, 16 and 41 is/are rejected.
- 7) ☐ Claim(s) 2, 11, 17, 18, 20, 21, 46, 48, 50, 51 and 53 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 07, 2003 has been entered.

2. Applicant's response to the Office Action mailed April 3, 2003 on October 29, 2003 is acknowledged. It is noted that applicant filed a Supplemental Amendment on October 30, 2003, which has been considered.

3. Claims 4-10, 22-29, 32-33, 35, 38 and 42 have been canceled. Claims 12, 14, 44, 45 and 46 have been amended. Claims 1-3, 11-21, 30, 31, 34, 36, 37, 39-54 are pending. Claims 1-3, 11, 13, 16-21, 30-31 and 41-54 are under examination.

4. The objection to the Specification and Rejections under 35 U.S.C. 112, first paragraph and 102 have been withdrawn as applicant's sequences as originally filed provides support for the insertion of the language "X is any amino acid other than cysteine".

***Claim Objection***

5. Claims 2, 11, 17-18, 20-21, 48, 46, 50-51 and 53 are objected to as the claims depend from a rejected based claim.

***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 16 and 41 remain rejected under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 remains indefinite because of the recitation of "an unspecified/unknown algorithm to be used to identify or design an amino acid sequence" as the metes and bounds of the method is not defined. The dependent claim is also included in this rejection.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102 (b) as being anticipated by Civelli et al. (U.S. Patent No. 5,422,265, June 6, 1995).

Civelli et al. disclose peptide sequences, which anticipates the sequence, contained in the formula C3XCnXC3XC wherein n is 11 or 12, X is any amino acid other than cysteine and C is cysteine, with a 100% sequence identity. The sequence disclosed by the reference is C3XC11XC3XC (see SEQ ID NO:17, residues 258 to 278) and as the claims recite the open language "comprising" the limitation of the claim is met by this reference (see sequence alignment).

8. Claim 1 remains rejected under 35 U.S.C. 102 (b) as being anticipated by Chio et al. (5468615, November 21, 1995).

Civelli et al. disclose peptide sequences, which anticipates the sequence, contained in the formula C3XCnXC3XC wherein n is 11 or 12, X is any amino acid other than cysteine and C is cysteine, with a 100% sequence identity. The sequence disclosed by the reference is C3XC11XC3XC (see SEQ ID NO:3, residues 258 to 278) and as the claims recite the open language "comprising" the limitation of the claim is met by this reference (see sequence alignment).

9. Applicant's arguments filed on October 29, 2003 and October 30, 2003 have been fully considered. Note that the rejections under 35 U.S.C. 112, first and 102 of record have been withdrawn. However, the rejections under 35 U.S.C. 112, second paragraph remains as applicant did not address the issue raised regarding claim 16 in the response. In addition, new grounds of rejections have been instituted over claim 1 for the reasons stated above under 35 U.S.C. 102.

### ***Conclusion***

10. Claims 3, 19, 30-31, 42-45, 47, 49, 52 and 54 are free of the art.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is (703)308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 5:30 P.M. (EST).


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703)308-2932.

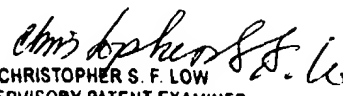
Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-2742. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

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Art Unit: 1653

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Hope A. Robinson, MS   
Patent Examiner

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
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